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EXAMINER

ARAQUE JR, GERARDO

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,754	<b>Applicant(s)</b> LEURS ET AL.	
	<b>Examiner</b> Gerardo Araque Jr.	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/15/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/15/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the applicant has failed to provide the correct application number for the Dimitrova reference, a copy of the WO 02080545, the two Non Patent Literature Documents. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Double Patenting***

3. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. US 20060100987 A1 (Serial Number: 10/533,753) in view of **Hane (US PGPub 2004/0083490 A1)** as shown in the rejections below. The Examiner asserts that the

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compending application comprises steps that are similar to the claimed invention since both disclose an invention directed to recommending content to a user based on a user's preference profile and using the information from the user preference profile in order to determine whether to recommend content to the user.

This is a provisional obviousness-type double patenting rejection.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the structural relationships of the claim limitations since one of ordinary skill in the art would not be able to comprehend the various differences and components of the invention since the applicant has only drawn various generic looking squares as described in the specification. Any structural detail that is essential for a proper

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understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1 – 18** are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office’s guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or

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materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is sufficiently tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not sufficiently tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **claims 1 – 18** are non-statutory since they may are not tied to another statutory class.

7. **Claims 19 and 21** are rejected under 35 USC 101 since the applicant is attempting to claim more than one statutory category. 35 USC 101 clearly states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claim 20** is rejected under 35 USC 101 since it is uncertain where a recommender falls under 35 USC 101, i.e. what statutory category it belongs in. 35 USC 101 clearly states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

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thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1 – 21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. In regards to **claim 1**, the Examiner is uncertain of what the applicant is attempting to disclose in the following limitation:

“...determining (205) if a first content item correlates with the user preference profile so as to have a high preference value;...”

As currently understood, it appears that the content item is being manipulated in some manner so that the content item will result in having a high preference value. However, upon reading the specification and remaining claims, it appears that the claim limitation should read as:

“...determining (205) if a first content correlates with the user preference profile to determine if the first content item has a high value;...”

Furthermore, for purposes of clarification, the Examiner recommends the applicant to change the term "it" to "first content item" as is found in **at least lines 7 and 12 of claim 1**. Similar situations can be found in **claim 20**.

12. In regards to **claim 3**, the Examiner is uncertain whether the applicant is claiming a second set of first and second characteristics and further recommends the applicant

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to change the terms "first and second characteristics" to "first characteristic and second characteristic".

13. **Claims 19 and 21** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in dependent form. As is currently written both claims are switching statutory category and it is unclear on how to interpret the claims since it is uncertain whether **claim 19 is a method or computer program** and whether **claim 21 is a different apparatus from the recommender system**.

14. In regards to **claim 20**, the Examiner is uncertain of what a "recommender" is. That is to say, is a "recommender" a system, process, apparatus, or etc.? For the purposes of examination the Examiner will understand **claim 20** to be a system (apparatus) claim.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. **Claims 1 – 11 and 15 – 19** are rejected under 35 U.S.C. 102(e) as being anticipated by **Hane (US PGPub 2004/0083490 A1)**.

17. In regards to **claims 1 and 19**, Hane discloses a method and program of providing a recommendation of content to a user the method comprising the steps of:

determining (201) a user preference profile for a user (**Page 1 ¶ 13 wherein a profile creator is used to create a user preference profile**);

determining (205) if a first content item correlates with the user preference profile so as to have a high preference value (**see at least Page 3 ¶ 68 wherein a program is searched for a recommended based on the user preference profile**); and

if the first content item has a high preference value recommending (206) it to a user (**see at least Page 6 ¶ 41; Page 7 ¶ 148 wherein programs that correlate with the user profile and have a high preference value are provided to the user and wherein the high preference value is determined based on how well the program correlates with the user preference profile**); and

if the first content item does not have a high preference value:

determining (211) if the first content item comprises at least a first characteristic having an associative correspondence to at least a second characteristic of a second content item having a high user preference and recommending it to the user only if there is such an associative correspondence (**see at least Page 6 ¶ 140; Page 7 ¶ 148 wherein programs that are not ranked high when initially correlated with the user preference profile is reanalyzed in order to determine whether the program should continue to be recommended to the user based on various stored parameters**

**[characteristics], including previous programs that have been stored/viewed).**

18. In regards to **claim 2**, **Hane** discloses wherein the first content item is recommended to the user if only a single associative correspondence between the first characteristic and the second characteristic is determined **(see at least Page 6 ¶ 140; Page 7 ¶ 148 wherein if a associative correspondence is found the content will be recommended).**

19. In regards to **claim 3**, **Hane** discloses wherein the associative correspondence is determined only for a single first and second characteristic **(see at least Page 1 ¶ 7; Page 2 ¶ 30 wherein the characteristic of why the program is being recommended may be at least because a specific actor appears in the program or keyword).**

20. In regards to **claim 4**, **Hane** discloses further comprising the step of determining a user preference for the first content item recommended from the associative correspondence and updating the user preference profile in response to the user preference **(Page 4 ¶ 94; Page 5 ¶ 113 - 116; Page 6 ¶ 130 wherein the system controller learns from the programs that have been selected to be recorded by the user and uses at least a morpheme analysis, for example, in order to determine various user preferences and is updated).**

21. In regards to **claim 5**, **Hane** discloses wherein the first characteristic is a first content description characteristic of the first content item and the second characteristic is a second content description characteristic of the second content item **(see at least**

**Page 4 ¶ 101 wherein the characteristic of the content can be comprised of at least the contents of the program).**

22. In regards to **claim 6**, **Hane** discloses wherein the first content description characteristic is derived from a first textual description associated with the first content item and the second content description characteristic is derived from a second textual description associated with the second content item **(see at least Page 4 ¶ 99 wherein a text analysis process is used).**

23. In regards to **claim 7**, **Hane** discloses wherein the associative correspondence is determined in response to an identification of a correspondence between at least one word of the first textual description and at least one word of the second textual description **(see at least Page 4 ¶ 99 wherein the results of the text analysis process is stored for use in determining a recommendation and uses the stored information, such as the information for the user “favorites”, in order to determine appropriate recommendations).**

24. In regards to **claim 8**, **Hane** discloses wherein the correspondence is determined in response to the at least one word of the first textual description having a similar meaning as the at least one word of the second textual description **(see at least Page 4 ¶ 98 wherein a morpheme analysis is used in order to use the definition of a word in order to determine the meaning of the explanation regarding each program).**

25. In regards to **claim 9**, **Hane** discloses wherein the correspondence is determined in response to the at least one word of the first textual description having an associative word correspondence to the at least one word of the second textual description, the

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associative word correspondence being determined from a database of word associations **(see at least Page 4 ¶ 98 – 99 wherein a word dictionary is used and stored within the system).**

26. In regards to **claim 10**, Hane discloses wherein the associative correspondence is determined in response to word combinations of at least one of the first and second textual content descriptions **(Page 4 ¶ 97 – 99 wherein brief explanations of the programs is used and stored into the system in order to determine the associative correspondence of the content items).**

27. In regards to **claim 11**, Hane discloses wherein at least one of the first and second characteristics is determined from a content analysis of the content item **(Page 4 ¶ 97 – 99; Page 4 ¶ 101 wherein the system uses at least the contents of the program and brief descriptions in determining the recommendation).**

28. In regards to **claim 15**, Hane discloses wherein at least one of the first and second characteristics is determined from a content item broadcast channel **(Page 4 ¶ 97 wherein the characteristics can be derived from at least the channel of the program).**

29. In regards to **claim 16**, Hane discloses wherein the step of determining the associative correspondence comprises determining a plurality of associative correspondences between a plurality of characteristics of the first content item and a plurality of characteristics of the second content item **(see at least Page 4 ¶ 101 wherein the characteristics used can be comprised of the program title, cast of the program, type of the program, and contents of the program).**

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30. In regards to **claim 17**, **Hane** discloses wherein the associative correspondence is further determined in response to a previous associative correspondence between content items (**see at least Page 4 ¶ 87; Page 5 ¶ 109, 115 wherein the system uses information from user favorite programs in order to determine the associative correspondence for recommending programs**).

31. In regards to **claim 18**, **Hane** discloses wherein at least one of the first and second characteristics is chosen from the group of (**see at least Page 4 ¶ 101 wherein the cast of the program is used**):

- a. an actor;
- b. a character played by an actor; and
- c. a location.

***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. **Claims 12 – 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hane (US PGPub 2004/0083490 A1)** in view of **Nicky Blackburn (Innovations; [Daily Edition])**.

34. In regards to **claims 12 – 14**, **Hane** discloses a system and method which analyzes the content of a program and uses the extracted information in order to

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determine whether the program should be recommended to the user based on stored information.

However, **Hane** fails to explicitly disclose:

wherein the content analysis comprises a content item video image analysis, content item audio analysis, and content item video object analysis.

**Blackburn** discloses that it is old and well known use video and audio analysis as a means of comparing the captured data with information stored within the system in order to provide key information to a user.

It would have been obvious to one having ordinary skill in the art to include in the recommendation system and method of **Hane** the ability to capture video and audio as a means of analyzing content as taught by **Blackburn** since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

35. **Claims 20 – 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hane (US PGPub 2004/0083490 A1)** in view of **Robert Cravotta (Exploring the anatomy of multiprocessor designs)**.

36. In regards to **claims 20 and 21**, **Hane** discloses a private video recorder (**Page 1 ¶ 24**) comprising a recommender for providing a recommendation of content to a user, as discussed above.

However, **Hanes** fails to disclose the recommender comprising:

a user profile processor; and

a recommender processor.

**Cravotta**, however, discloses that it is old and well known to use multiple processors for computer system in order to provide more processing power than a single processor can accomplish. Multiple processors take advantage of the processing power by allowing the system to accomplish more tasks in less time by dividing the workload. One of ordinary skill in the art would have realized the advantages of using a multiprocessor system for the recommender, as taught by **Hane**, in order to take advantage of searching through the various characteristics in order to determine best content item to provide to the user as fast and efficiently as possible.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include a multiprocessor system, as taught by **Cravotta**, in the recommender system, as taught by **Hane**, in order to provide the content item to the user as fast and efficiently as possible since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding the following limitations:

a user profile processor (113) for determining a user preference profile for a user;  
a recommender processor (111) for determining if a first content item correlates with the user preference profile so as to have a high preference value; and  
if the first content item has a high preference value recommending it to a user;  
and

if the first content item does not have a high preference value:

determining if the first content item comprises at least a first characteristic having an associative correspondence to at least a second characteristic of a second content item having a high user preference and recommending it to the user only if there is such an associative correspondence;

the Examiner considers them to be nonfunctional descriptive subject matter. As a further note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Specifically, the Examiner understands the claims to be directed towards a system and apparatus and, consequently, the data that is being processed does not add any further structural components to the claim. In other words, the type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art.

### ***Conclusion***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./  
Examiner, Art Unit 3689  
1/14/09

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
January 17, 2009

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